

Application Serial Number 10/717,226

Attorney Docket No. 39894-00601

REMARKS**RECEIVED
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Claims 158-164, and 166-218 are pending.

Claim 165 has been deleted to overcome the objection by the Examiner.

Applicants wish to thank Examiner Lezah Roberts and Primary Examiner Frederick Krass for extending the courtesy of an interview on July 31, 2006. Applicants have reviewed the Interview Summary and, as noted below, the rejections regarding the Sagel et al., Tapolsky et al. and Chen et al. references have been resolved.

Rejection under 35 U.S.C. §102(e)

Claims 203-204, 208-212, 214 and 217-218 has been rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent Application No. 2002/0141950 ("Chen et al."). The present application claims the priority of, *inter alia*, Korean patent applications 2000-13636 and 2000-74599 filed March 17, 2000 and December 8, 2000, respectively. Both dates are earlier than Chen et. al., priority based on application 09,770,446 filed on January 27, 2001. Original certified copies of the translations of these Korean applications were filed in the parent 10/049,817 application. For the convenience of the Examiner, applicants hereby submit additional copies of the translations. Please note that use of PVP is disclosed, *inter alia*, on page 4 of the '636 application and in Example 1 of the '599 application. Applicants therefore respectfully request removal of this ground of rejection.

Rejection under 35 U.S.C. §103(a)

1) Examiner states in the Office Action that claims 158-218 are rejected under 35 U.S.C. §103(a) over U.S. Patent No. 6,136,297 ("Sagel et al.") in view of U.S. Patent No. 6,159,498 ("Tapolsky et.al."). Applicants respectfully traverse. As pointed out by the Examiner, Tapolsky, et al. does not teach peroxide or sodium tripalylphosphate in the composition. As noted in the

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Interview Summary independent claims 34, 43 and 49 each includes the functional feature of a "patch is in a dry state...and is adapted to strongly adhereupon being hydrated" ("dry-type feature) which is not disclosed or suggested by, and distinguishes over Sagel et al., Tapolsky et al. and Chen et al. Accordingly, Applicants respectfully submit that the foregoing rejections under 35 U.S.C. § 103(a) have been obviated.

Accordingly, Applicants respectfully request removal of this ground of rejection.

- 2) Claims 187-194, 196-202 and 215-216 have been rejected under 35 U.S.C §103(a) over Chen et.al., in view of Patent WO 95/17158 ("Gallop et.al."). As noted above, the present application claims priority to Korean priority applications which pre-date Chen et al. Accordingly, Applicants therefore respectfully request removal of this ground of rejection.

Obviousness Double Patenting Rejection

- 1) Claims 158-218 have been provisionally rejected under obviousness-type double patenting over U.S. Application No. 10/915,283 ("Kim et.al."), claims 34-66, in view of Tapolsky et al. Examiner states that the provisional rejection may be overcome by filing a terminal disclaimer in compliance with 37 C.F.R. § 1.321(c). Applicants enclose a compliant terminal disclaimer and respectfully requests that the Examiner withdraw the provisional rejection.

- 2) Claims 158-218 have been provisionally rejected under obviousness-type double patenting over U.S. Patent No. 6,946,142 ("Chang et. al.": claims 13-17), in view of U.S. Patent No. 5,130,124 ("Merianos et al."). As noted above, the present application claims the priority of, *inter alia*, Korean patent applications 2000-13636 and 2000-74599 filed March 17, 2000 and December 8, 2000, respectively. In contrast, the '142 patent is based on later-filed Korean patent

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applications 01-0036024 and 01-0039847 filed June 23, 2001 and July 4, 2001, respectively. Applicants could not have filed an application containing both inventions since the priority date of the '142 patent is more than a year after the earliest priority date of the present application. Applicants also respectfully traverse the assertion that the invention claimed in the '142 patent would have been obvious over the invention in the present application. In the grandparent '817 application as well as in Application No. 10/177,689 that issued as the '142 patent, applicants presented arguments, and the PTO accepted, that the claimed inventions were patentably distinct. The '142 patent claims a dry-type patch having three or more layers wherein a contact adhesive layer encapsulates a peroxide reservoir layer against a backing layer. Furthermore, as noted above, nothing in Merianos et al. discloses or suggests the formation of a dry type reservoir film nor a dry type contact adhesive layer that is substantially free of peroxide whitening agent. Accordingly, withdrawal of this grounds of rejection is respectfully requested.

3) Claims 158-218 have been rejected under obviousness-type double patenting over U.S. Patent No. 6,682,721 ("Kim et. al."), claims 1-3, in view "Merianos et al.". Examiner states that the rejection may be overcome by filing a terminal disclaimer in compliance with 37 C.F.R. § 1.321(c). Applicants enclose a compliant terminal disclaimer and respectfully requests that the Examiner withdraw the rejection.

4) Claims 158-218 have been rejected under obviousness-type double patenting over U.S. Patent No. 6,780,401 ("Kim et.al."), claims 1-3, 5-6, 9-12, 15, 17, 20-23 in view of Merianos et al. Examiner states that the rejection may be overcome by filing a terminal disclaimer in compliance with 37 C.F.R. § 1.321(c). Applicants enclose a compliant terminal disclaimer and respectfully requests that the Examiner withdraw the rejection.

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CONCLUSION

Applicants submit that all the claims are in condition for allowance and Applicants respectfully request that all claims be allowed.

Applicants request that any questions concerning this matter be directed to the undersigned at (609) 895-6639. If a telephone conference would be of assistance in advancing the prosecution of the present application, Applicants' undersigned attorney invites the Examiner to telephone at the number provided.

Applicants also authorize the charge of any deficiency and/or the credit of any overpayment to deposit account 50-1943.

Respectfully submitted,



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